

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

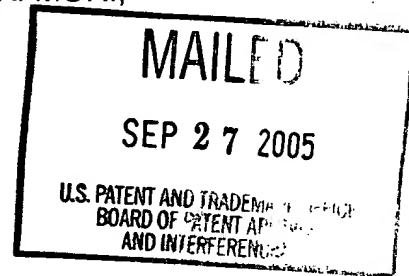
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HIDEKAZU TANAKA, KIYOAKI MORI,
and SHUICHI TSUNETSUGU

Appeal No. 2005-1915
Application No. 09/868,256

ON BRIEF



Before WILLIAM F. SMITH, MILLS, and GREEN, Administrative Patent Judges.
GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 2 and 4-10. Claims 1 and 8 are representative of the subject matter on appeal, and read as follows:

1. A transparent skin care composition comprising:
 - (a) from about 0.001 to about 5% of a surfactant combination comprising i), ii), and iii) wherein i) is a polyoxyethylene sorbit tetraalkyl ester, ii) is a polyoxyethylene castor oil ester and/or polyoxyethylene hydrogenated castor oil ester; and iii) is a polyoxyethylene alkyl phosphate or salts;

- (b) from about 0.001 to about 5.0% of an oil compound;
- (c) from about 0.01 to about 10% of a polyhydric alcohol; and
- (d) from about 60 to about 99.8% of water;

wherein the oil compound is substantially solubilized in the transparent skin care composition.

8. A transparent skin composition comprising:

- (a) from about 0.001 to about 5.0% of two or more surfactants selected from the group consisting of polyoxyethylene sorbit tetraalkyl ester, polyoxyethylene castor oil ester and/or polyoxyethylene hydrogenated castor oil ester; polyoxyethylene alkyl phosphate or salts, and mixtures thereof;
- (b) from about 0.001 to about 5.0% of an oil compound;
- (c) from about 0.01 to about 10% of a polyhydric alcohol; and
- (d) from about 60 to about 99.8% of water;

wherein the oil compound is substantially solubilized in the transparent skin care composition.

The examiner relies upon the following references:

Koyanagi et al. (Koyanagi)	5,474,776	Dec.12,1995
Motono	4,985,455	Jan,15,1991
SUMIDA	JP-48925	Feb. 18, 1992
SUGIZAKI	JP-3-115208	May 16, 1991

Claims 1, 2 and 4-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Sumida and Motono or Sugizaki. In addition, claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Koyanagi and Motono or Sugizaki. After careful review of the record and consideration of the issues before us, we affirm the rejection of claims 1, 2 and 4-10 over the combination of Sumida and Motono or Sugizaki.

Because that rejection reaches all of the claims on appeal, we declined to reach the rejection of claims 8-10 under 35 U.S.C. § 103(a) as being obvious over the combination of Koyanagi and Motonoto or Sugizaki.

DISCUSSION

As the claims stand or fall together, see Appeal Brief, page 2, we focus our analysis on claim 8, the broadest claim.

Claim 8 is drawn to a composition comprising:

- about 0.001 to about 5.0% of two or more surfactants selected from the group consisting of polyoxyethylene sorbit tetraalkyl ester, polyoxyethylene castor oil ester and/or polyoxyethylene hydrogenated castor oil ester; polyoxyethylene alkyl phosphate or salts, and mixtures thereof;
- about 0.001 to about 5.0% of an oil compound;
- about 0.01 to about 10% of a polyhydric alcohol; and
- about 60 to 99.8% of water.

Note that claim 8 does not require the presence of polyoxyethylene sorbit tetraalkyl ester, as only two surfactants are required by the claim.

Claims 1, 2 and 4-10 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Sumida and Motonoto or Sugizaki.

Sumida is cited for teaching a "transparent microemulsion composition comprising (a) 0.1-30.0 wt% of nonionic surfactants which include polyoxyethylene castor oil or hardened castor oil derivatives; (b) 0.001-20 wt % of ionic surfactants which include polyoxyethylene alkyl ester phosphate; (c) 0.1-30

wt % of oil; and (d) 40-99 wt % of water.” Examiner’s Answer, page 3, citing pages 2-6 of the Translation. Sumada is also cited for teaching the use of polyhydric alcohol. See id. (citing Example 1 on page 8 of the translation). In addition, the examiner asserts that “[a]lthough the specific ratio of each surfactants are [sic] not disclosed in the reference, examiner views that given the teachings of the preferred surfactants and their amounts in the composition, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experiments.” Id. at 4.

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citations omitted). The test of obviousness is “whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention.” In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

As Sumida teaches all of the components of the claimed composition, we find that Sumida renders the invention of claim 8 obvious, and the rejection is affirmed. Although the Sumida translation does not provide the amount of polyhydric alcohol in the composition, as noted by the examiner, one of ordinary skill in the art would have discovered the optimum range of the amount of the components by routine experimentation. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) (“[D]iscovery of an optimum value of a result

effective variable in a known process is ordinarily within the skill of the art.” (citations omitted)); see also In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). The Motono and Sugizaki references were relied upon for teaching a composition comprising polyoxyethylene sorbit tetraalkyl ester. See Examiner’s Answer, page 4. The presence of that surfactant, however, is not required claim 8, the representative claim, thus we need not address the teachings of those references

Appellants argue that Sumida teaches the use of a microfluidizer to form a microemulsion, therefore there is no motivation “to explore a combination of surfactants, which would solubilize the oil without the use of a microfluidizer.” Appeal Brief, page 3. Appellants argue further that “Sumida teaches mono, tri and penta alkyl esters including POE monooleates, monostearates, triolates and pentaoleates, however, not tetra alkyl esters,” asserting that “[o]ne skilled in the art, noticing the conspicuous avoidance of tetra alkyl esters would actually be led away from applying them to the presently claimed compositions.” Id. at 3 (emphasis in original).

Appellants’ arguments are not convincing. As discussed above, claim 8 only requires the presence of two surfactants, neither of which need be polyoxyethylene sorbit tetraalkyl ester. Sumida teaches a combination of two surfactants, polyoxyethylene castor oil or hardened castor oil derivatives and polyoxyethylene alkyl ester phosphates, and thus the fact that Sumida does not

provide motivation to add a third surfactant, such as polyoxyethylene sorbit
tetraalkyl ester, is irrelevant.

No time period for taking any subsequent action in connection with this
appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


William R. Smith

Administrative Patent Judge


Demetra J. Mills

Administrative Patent Judge


Lora M. Green

Administrative Patent Judge

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